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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,917	09/08/2000	David Matthew Smith	DMS2K001	2508

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EXAMINER

FOSTER, ROLAND G

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/657,917

**Applicant(s)**

SMITH, DAVID MATTHEW

**Examiner**

Roland G. Foster

**Art Unit**

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-12,14,16,17,19 and 20 is/are rejected.
- 7) ☒ Claim(s) 2,9,13,15 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Arguments***

In the amendment, filed on March 08, 2004 as Paper No. 4, the applicant argues that it would not have been obvious to combine deCuitiss (U.S. Patent No. 5,668,955) with Manning (U.S. Patent No. 5,898,756) because deCuitiss uses serial connection circuitry while Manning uses parallel connection circuitry.

Although the applicant's arguments have been duly considered, they are not deemed persuasive. As discussed in the prior Office action, Manning expressly provides the teachings, and advantages in modifying auto-dialer, serial connection circuitry similar to deCuitiss in order to provide a parallel connection. Further, both deCuitiss and Manning are narrowly directed to the same field of endeavor: auto-dialers capable of inserting an access code into a dialing sequence. Thus, it would have been obvious to combine deCiuttis with Manning.

For the reasons above, the following rejections are repeated, except where any new grounds of rejection are due to the amendment to the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-8, 10-12, 14, 16, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,668,955 to deCiutiis et al. ("deCiutiis"), of record, in view of U.S. Patent No. 5,898,756 to Manning et al. ("Manning"), of record.

With respect to claim 1, see the following paragraphs for details on how Manning anticipates certain limitations within the claim.

The limitation "receiving a first digit by said automatic dialing device from a telephone" reads on deCiutiss as follows. A first digit is received (Fig. 2B-1, "1<sup>st</sup> digit dialed?") by the series connected automated dialer (Fig. 1-1) received from a telephone (Fig. 1-1, subscriber's telephone set 4).

The limitation "decoding a digit value of said first digit" reads on Figs. 2B-1, "1<sup>st</sup> DIGIT=1".

The limitation "waiting for a predetermined digit interval of time for reception of a subsequently received second digit from said telephone network" reads on Fig. 2B-2 where the dialer "wait[s] for the next digit" (i.e., waits a predetermined amount of time necessary to determine that no subsequent digit has been received).

The limitation "automatically dialing onto said telephone network a predetermined access network digit or strings of digits if said predetermined digit interval of time is elapsed prior to reception of said second digit" reads deCiutiis as follows. The system "wait[s] for next digit" for a amount of time until on the system determines whether the "digit [was] dialed, y/n." If no, then the system skips to the exception checking step and eventually to the dialing step where the access code is dialed.

The limitation "such that said digit access digit or string of digits is automatically dialed following completion of the first received digits and prior to reception of subsequently received digits" reads on Fig. 2B-2, "transmit access code" and col. 16, lines 1-5 where the access code is inserted into the dialed telephone number.

DeCiutiis discloses a series connected, auto-dialer (Fig. 1-1), and thus fails to disclose that the first digits are received via a "telephone network" where the automatic dialing device has a "parallel electrical connection with the telephone network."

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However, Manning (similarly to deCiutiis) teaches of a auto-dialer capable of inserting an access code into the dialing sequence (abstract) that is also connected in parallel to the subscriber line (telephone network)<sup>1</sup> (abstract and Fig. 1) and thus is capable of receiving the digits via the telephone network.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the parallel connection arrangement as taught by the auto-dialer capable of inserting an access code codes into the dialing sequence to the serially connected, auto-dialer capable of inserting an access code into the dialing sequence as disclosed by DeCiutiis.

The suggestion/motivation for doing so would have been to decrease the ease of installation because the "principle downside of serial-connected speed dialers is the difficulty of installation" (Manning, col. 1 lines 29-50). In addition, the parallel connected arrangement of Manning "provides[s] for transparency to the user" (Manning, col. 2, line 20-60).

Claim 8 differs substantively from claim 1 in that claim 8 recites a computer program implemented by a processor that performs functions equivalent to the method steps of claim 1. The processor reads on the microcontroller (Fig. 1-2).

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<sup>1</sup> Equating the subscriber line to the telephone network is consistent with the applicant's specification (e.g., Fig. 1A).

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Claim 14 differs substantively from claim 1 in that claim 14 recites a device comprising components that perform functions equivalent to the method steps of claim 1. The "parallel telephone connection" reads on Manning, abstract and Fig. 1 and was added in the claim 1 rejection above. The "digit detector" reads on deCiutiis, Fig. 1-1, DTMF decode 15. The digit transmitter" reads on deCiutiis, DTMF generator 13.

With respect to claim 3, see the claim 1 rejection for details regarding the parallel connection.

With respect to claims 4, 10, and 20, see deCiutiis, Fig. 2A-1 where the off-hook or ring awakens the system by applying power.

With respect to claims 5 and 11, see deCiutiis, Fig. 2B-1 where a "0" is entered which disable transmission of stored digits.

With respect to claims 6 and 12, see deCiutiis, Fig. 2B-1 where the system turns off.

With respect to claims 7 and 16, if the second digit is part of the exception code (Fig. 2B-2), then the system will not dial an access code and then turn off (Fig. 2B-1).

With respect to claim 17, see Fig. 2A-1, "power up."

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With respect to claim 19, see Fig. 2B-1 regarding power down.

***Allowable Subject Matter***

Claims 2, 9, 13, 15, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Examiner's Reasons for Allowance***

With respect to claims 2, 9, and 15, see pages 7 and 8 of the last Office action, mailed on Oct. 01, 2003 as Paper No. 3, for further details regarding the examiner's reasons for allowance.



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***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster  
Patent Examiner  
May 13, 2004